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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,652	01/29/2001	Dominique Dreher	032326-114	2648

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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 09/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/744,652

Applicant(s)

DREHER ET AL.

Examiner

Michael J Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9 and 11-17 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The IDS of 1/29/01 was received and considered.
2. Claims 1-17 are pending.

Claim Objections

3. Claims 5-9 are objected to because of the following informalities: The preamble of claims 5-9 recite "A method of exchange of/exchanging messages", but depending claim 1 is a method of "monitoring an execution of a request ...". Appropriate correction is required. *For the purposes of this Office Action, the preambles of claims 5-9 will be understood to recite "A method according to Claim ...".*

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5 & 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recites the limitation "real time" which is not clearly defined in the specification. The concept of "real time" transfers is highly relative and therefore must be clearly defined when used as a limitation. *For the purposes of this Office Action, "real time" is defined as "Of or relating to a time frame imposed by external constraints. Real-time operations are those in which the machine's activities match the human perception of time or those in which computer operations proceed at*

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the same rate as a physical or external process." Claims 6 & 8-9 are rejected based on their dependence on claims 5 & 7.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5 & 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the term 'real-time' is a relative, human perceptible characteristic and is therefore related to the use of the system. Claims 6 & 8-9 are rejected based on their dependence on claims 5 & 7.

8. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites that the values are transmitted in protected form, however, the values in Claim 3 are the values on the card and server and are not transmitted – the variation is transmitted. *For the purposes of this Office Action, the 'values' recited in claim 4 will be understood to refer to the variation in claim 3.*

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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10. Claims 1 & 5, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,856,659 to Drupsteen et al. (Drupsteen). Drupsteen discloses sending by the server/outside source (col. 3, lines 35-38) including a request/INIT (Fig. 3) to perform one or more actions/transfer commands to be implemented by the card (col. 4, lines 22-30), the server stores the number/N of actions/transfer commands in the request/INIT (Fig. 3), on reception of the message, the card successively executes the action or actions/transfer commands in the request whilst incrementing its action counter/T/S between each action if the action is properly executed/verified (Fig. 5) and refusing this action and successive actions/exit if validity check fails (Fig. 5) if the action has not been correctly executed, without incrementing its counter/T, and the variation between the value in the card and the one stored in the server are compared and a determination is made that the last x actions are not executed if the result of the comparison has a difference of x (result of Fig. 5).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen, as applied to claim 1 above, in further view of U.S. Patent 5,191,193 to Le Roux, in further view of U.S. Patent 5,731,576 to Valadier. Drupsteen lacks transmitting the value of the counter to the server before and after execution of the action. However, Le Roux teaches a system where a signature and a counter is kept on a card, wherein the counter is sent to a verification

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device/server to verify that the card is in the correct state for purchasing (col. 3, line 28 – col. 4, line 64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send the current value of the counter to the server/terminal before and after the transaction. One of ordinary skill in the art would have been motivated to perform such a modification to verify the card's state, as taught by Le Roux (col. 3, line 28 – col. 4, line 64). Drupsteen, as modified above, lacks explicitly sending the value before a transaction. However, Valadier teaches that incrementing a counter value before a transaction allows fraud detection (col. 6, lines 63-66). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to also send the value of the counter to the server before the transaction. One of ordinary skill in the art would have been motivated to perform such a modification to enable fraud detection, as taught by Valadier (col. 6, lines 63-66).

13. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen, as applied to claim 1 above, in further view of U.S. Patent 5,191,193 to Le Roux. Drupsteen discloses an application, which executes actions/ transfer commands (col. 4, lines 22-30) in response to a transaction request/INIT (Fig. 3) received from a server/outside source (col. 1, lines 30-50 & col. 3, lines 35-38), an action counter/T and a counter manager which increments said action counter/T upon proper execution/verification of each action/transfer and inhibits the incrementing of the counter for any action/transfer which is not properly executed/verified (Fig. 3) and all successive actions in a transaction (Fig. 3 & Fig. 5). Drupsteen lacks the counter manager transmitting the value of said counter to the server. However, Le Roux teaches a system where a signature and a counter is kept on a card, wherein the counter is sent to a verification device/server to verify that the card is in the correct state for purchasing (col. 3, line

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28 – col. 4, line 64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send the current value of the counter to the server/terminal before and after the transaction. One of ordinary skill in the art would have been motivated to perform such a modification to verify the card's state, as taught by Le Roux (col. 3, line 28 – col. 4, line 64).

14. Claim 6, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen, as applied to claim 1 above, in further view of U.S. Patent 5,404,461 to Olnowich et al. (Olnowich). Drupsteen lacks transmitting the counter by means of a message acknowledging the current transaction in the card. However, Olnowich teaches that sending an acknowledgement provides a sender with verification that a transmission has been completed successfully (col. 5, lines 59-62). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the card counter value in a message acknowledging the current transaction. One of ordinary skill in the art would have been motivated to perform such a modification to provide the sender/server with verification that the transaction has completed successfully, as taught by Olnowich (col. 5, lines 59-62).

15. Claims 7 & 16-17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen, as applied to claim 1 above, in further view of U.S. Patent 6,002,787 to Takhar et al. (Takhar). Drupsteen, as best understood, lacks the transmission occurring in non-real time. However, Takhar teaches that due to communication delays, off-line batch processing is often used (col. 11, lines 49-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit the action counter/T/S in non-real time. One of ordinary skill in the art would have been motivated to

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perform such a modification because a direct real-time connection may not be desirable or feasible, as taught by Takhar (col. 11, lines 49-53).

16. Claims 8-9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen in view of Takhar, as applied to claim 7 above, in further view of Le Roux.

Drupsteen lacks transmitting the value of the counter to the server by means of a message of a new transaction request b the card for the server. However, Le Roux teaches a system where a signature and a counter is kept on a card, wherein the counter is sent to a verification device/server to verify that the card is in the correct state for purchasing (col. 3, line 28 – col. 4, line 64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send the current value of the counter to the server/terminal before and after the transaction. One of ordinary skill in the art would have been motivated to perform such a modification to verify the card's state, as taught by Le Roux (col. 3, line 28 – col. 4, line 64).

17. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen in view of Le Roux, as applied to claim 14 above, in further view of Olnowich. Claim 15 is substantially similar to claim 6, and is therefore rejected under similar rationale.

Allowable Subject Matter

18. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (703)305-8191.

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The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. - 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703)308-4789.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

(703)746-7239 (for formal communications intended for entry)


Or:

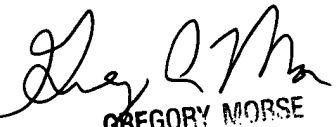
(703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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August 30, 2004


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